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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,960	07/24/2003	Johannes Ruetschi	2003P04023 US	1613

7590 08/05/2009

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ART UNIT	PAPER NUMBER
2626	

MAIL DATE	DELIVERY MODE
08/05/2009	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/625,960
Filing Date: July 24, 2003
Appellant(s): RUETSCHI, JOHANNES

Charles W. Peterson, Jr., Reg. No. 34,406
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 April 2009 appealing from the Office action mailed 11 December 2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The claim amendments filed 16 April 2009 merely serve to resolve antecedent basis under 35 U.S.C. 112 and are sufficient to be approved for entry. The amendments do not substantively affect the issues before the board.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0129057 A1	Spielberg	Published September 12, 2002
EP 0 865 189 A2	Pizano *et al.*	Published September 16, 1998
US Patent No. 5,754,844	Fuller	Published

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 7-10, 12-18, 21-22, 25, 27-30 and 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated by **Spielberg (US 2002/0129057 A1)** referred to as **SPIELBERG** hereinafter.

Claims 1 and 21: **SPIELBERG** discloses a method and apparatus for inserting a user's speech annotations into a message (page 1, paragraph [0018], *'a system that enables people to add verbal annotations (i.e. add comments) to a digital document such as a movie script, book, or any other type of document.')*, comprising:

i. providing a speech rendering of said original message (page 1, paragraph [0018], *'The system can read documents (e.g., via a text-to-speech engine) so that the reviewer can hear the contents of the document.'*);

ii. annotating said speech message with at least one speech annotation (Figure 5; page 1-2, paragraph [0018], *'The system also provides the reviewer with a way to record verbal comments about the document.'*); and

iii. inserting said speech annotation into said original message (page 2, paragraph [0018], *'When a comment is supplied the comment becomes associated with the location in the document where the comment was provided. If, for example, the reviewer makes a comment about a particular passage of text, the comment becomes associated with the passage of text the comment is related to.'*).

Claims 2 and 22: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above wherein said original message is a text E-mail message (Abstract, *'to review and add any number of annotations (i.e. add comments) to a digital document such as movie scripts, books, etc.'* As it is well-known, E-mail messages are electronic by nature, therefore, **SPIELBERG** implicitly states the availability of using the system to annotate E-mail messages. See also page 5, paragraph [0052]) provided by accessing a Unified Messaging [Document] server (page 5, paragraph [0045]) and retrieving said text email message (page 5, paragraph [0045]).

Claims 5 and 25: **SPIELBERG** discloses a method and apparatus as per claims 2 and 22 above wherein said step of providing a speech rendering of said original message comprises converting said text message to speech (page 1, paragraph [0018], *'The system can read*

documents (e.g., via a text-to-speech engine) so that the reviewer can hear the contents of the document.').

Claims 7 and 27: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of connecting to the mailbox of said email message by establishing a voice connection using a landline telephone or a mobile telephone (page 5, paragraph [0051], [0052]).

Claims 8 and 28: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above wherein said annotating step includes recognition of predefined commands for starting and stopping said speech annotation (page 4, paragraph [0044] and page 5, paragraph [0046]).

Claims 9, 12, 29 and 32: **SPIELBERG** discloses a method and apparatus as per claims 8 and 28 above, wherein a user has the capability to interact with a system using predetermined commands (page 6, paragraph [0055]) and wherein said commands are user-defined speech commands (page 6, paragraph [0055], Other playback control functions can be added to optimize user capabilities.).

Claims 10 and 30: **SPIELBERG** discloses a method and apparatus as per claims 8 and 28 above wherein said commands are entered via Dual Tone Multi-Frequency (DTMF) tones (page 5, paragraph [0050]).

Claims 13 and 33: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of recognizing said speech annotations of said caller (page 1-2, paragraph [0018], *'The system also provides the reviewer with a way to record verbal comments about the document.'*; page 5, paragraph [0052]).

Claims 14 and 34: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of converting said speech annotations to text (page 7, paragraph [0066]).

Claims 15 and 35: **SPIELBERG** discloses a method and apparatus as per claims 14 and 34 above wherein said step of converting annotated voice command to text is accomplished using Automatic Speech Recognition (ASR) and Speech-to-Text conversion (page 7, paragraph [0066]).

Claims 16 and 36: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, wherein said speech annotation is inserted in said original message as a text file (page 7, paragraph [0066], *'converts the recorded data to proper format for storing…the comments may also be converted to text…'*).

Claims 17 and 37: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, wherein said speech annotation is inserted in said original message as a sound file (page 7, paragraph [0066], *'converts the recorded data to proper format for storing…the comments are stored as sound data…'*).

Claims 18 and 38: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of storing said annotated message at the Unified Messaging server after inserting said speech annotation into said message (page 7, paragraph [0066], *'before saving the comments in the data structure.'*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4, 6, 11, 20, 23-23, 26, 31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG** in view of **Pizano (EP 0 865 189 A2)** referred to as **PIZANO** hereinafter.

Claims 3 and 23: **SPIELBERG** discloses a method and apparatus as per claims 1 and 21 above however failing to, but **PIZANO** does specifically disclose wherein said original message contains at least one attached document (page 2, lines 22-26, Fig. 16).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 4 and 24: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above wherein original message is a voice message (page 2, lines 29-33) provided by accessing a Unified [Universal] Messaging server (Abstract) and retrieving said voice message (Abstract, p. 2, lines 17-22).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 6 and 26: **PIZANO** discloses a method and apparatus as per claims 3 and 33 above wherein said step of providing a speech rendering of said original message comprises converting said attachment to speech (page 2, lines 34-36, 'controls a media converter which converts media to fax or *media to audio and an audio/fax player*,' [emphasis supplied]).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 11 and 31: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of using an interactive voice response (IVR) (page 5, lines 31-55 discloses wherein a prerecorded voice interactively responds to commands spoken and entered via DTMF by a user.).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it

provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 20 and 40: **PIZANO** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of forwarding said annotated message to another user (page 4, line 29, *'which delivers it as a voice message to the originator.'*).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **PIZANO** in the system of **SPIELBERG** because it provides the user the ability to remotely access and comment on documents and messages stored on a universal server, therefore allowing access to typically computer-only accessible formats (e.g. E-mail, electronic documents, electronic voice mail) in non-computer accessible environments (i.e. through fax or phone).

Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG**.

Claims 19 and 39: **SPIELBERG** discloses a method and apparatus as per claims 18 and 38 above, however failing to distinctly disclose wherein a new copy of an annotated message is created with inserted annotations (It appears as though the newly added language appears to merely re-iterate what was already being claimed [i.e., 'storing said annotated message'].). **SPIELBERG** does disclose wherein an annotated message (which would inherently include the message along with any annotations.) is saved for use later.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create another copy since it was known to one possessing ordinary skill in the art that if the capability to save a document or message is present, it is common knowledge within the computing arts that it is also possible to recreate said document a multitude of times.

One of the key advantageous features of digital storage is the constant reproducibility of results useful in 'backing up' important documents. This allows for the storage of a master copy on a server in the event that an important annotated message becomes lost or corrupted, while still providing other copies to be distributed to the people of which the message was originally intended.

Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **SPIELBERG** in view of **Fuller (US Patent No. 5,754,844)** referred to as **FULLER** hereinafter.

Claims 41-42: **SPIELBERG** discloses a method and apparatus as per claims 18 and 28 above, however failing to but **FULLER** does specifically disclose querying a user to either overwrite a file or to save as a new copy and subsequently performing said task based on user request (col. 8, lines 38-47).

Therefore, it would have been obvious to one possessing ordinary skill in the art at the time of invention to include the teachings of **FULLER** in the system of **SPIELBERG** because prompting a user as to whether a new file should be saved in a different location as opposed to overwriting an older file is a well-known technique in computer processing. This serves either to conserve storage space when an older file is obsolete or to create a large amount of saved data for backup purposes at the expense of storage capacity.

(10) Response to Argument

Response to Arguments With Respect to Rejection Under 35 U.S.C. § 102(e)

Appellant's key assertion is that **SPEILBERG** fails to teach or even suggest, 'inserting a caller's speech annotations into an original message.' The examiner respectfully disagrees with this assertion. **SPEILBERG** teaches a system for inserting speech annotations in clear anticipation of the instant claims and the following passages from **SPIELBERG** support the clear insertion of speech annotations [comments] into a digital document (e.g., message, e-mail, file, etc.).

[All emphasis original]

Abstract:

> *In one or more embodiments of the invention, the apparatus and methods described herein* ***allows users to review and add any number of annotations (i.e. add comments) to a digital document*** *such as movie scripts, books, etc. from anywhere in the world. For instance, the invention may play the document to the user via an audio output mechanism and provides the user with a way to comment on the document by simply speaking to an audio input mechanism. ...Each of the devices that embody the invention may access the document so as to provide the user with a way to review documents from multiple locations using multiple types of devices. The user may, for example, begin reviewing a document in an automobile, continue to review the document via a cell phone, and finish reviewing the document from home using a regular phone line.*

Pages 2-3, paragraph [0018]:

> *An embodiment of the invention describes* ***a system that enables people to add verbal annotations (i.e. add comments) to a digital document*** *such as a movie script, book, or any other type of document...For example, the reviewer may utilize an embodiment of the invention to access and* ***verbally comment on a document from multiple locations...The system can read documents (e.g., via a text-to-speech engine) so that the reviewer can hear the contents of the document.*** *The system also provides the reviewer with a way to record verbal comments about the document.* ***When a comment is supplied the comment becomes associated with the location in the document where the comment was provided.*** *If, for example, the reviewer makes*

> *a comment about a particular passage of text, the comment becomes associated with the passage of text the comment is related to.*

Page 3, Paragraph [0019]:

> *The device that embodies the invention uses an audio output mechanism to play the document to the user. At any time during playback the user may provide a comment by selecting an annotate button and simply speaking to the device.* ***In turn, the device records the user's comment and associates it with the location in the document where the comment was given. If the document is replayed after a user provides comments, the device plays back the document and the comments via the audio output mechanism.*** *This way the user can hear the document and any comments that were made about the document.*

It is worth noting from the outset that there is a misconception throughout appellants' arguments that there would appear to be some single 'master' file containing the original content along with a user's annotations presented in a way different from that of **SPIELBERG**. This point of view simply does not correspond to either the claims or specification as filed. It is clear throughout the disclosure of appellant's invention that a sound file is created (which inherently must be saved or at the least temporarily stored at some location) and later on down the chain of steps, can be inserted in a desired location for playback (*see at least* appellants' Fig. 2, step **250** [Exhibit A as supplied as evidence by appellant]). The examiner fails to see any difference between the actual scope of invention and the teachings of **SPEILBERG**.

Applicant asserts that, 'there is nothing…anywhere else in **SPIELBERG**, as far as the appellant can tell, about inserting the annotations into the document to produce an annotated document. Quite the opposite in fact.' The examiner points to the following paragraphs of **SPIELBERG** that appear to be doing the above.

> *[0044] The text-to-speech operation that prepares the document data for audible playback to the user may occur at server 312 or at annotation device 300. In one embodiment of the invention, the user of annotation device 300 may begin reviewing a document by identifying which document to review and selecting play button 312. This causes the device to audibly playback the document to the user via audio output 310. If the document was originally text, the device converts the text into sound files (e.g., via the text-to-speech engine) before it sends the sound data to audio output 310.* ***Any time during playback of the document, the user may verbally insert comments into the document by selecting annotate button 313. Upon activation of annotate button 313, annotation device 300 begins to collect audible comments provided by the user via audio input 310.*** *Thus, the annotation device comprises a mechanism such as a microphone for collecting audible words (e.g., comments/annotations) from the user.*
>
> *[0045] Each comment the user provides is stored by the system in memory (on the client device or the document server) and associated with a location in the document that is contextually relevant to the comment. If, for instance, the document is a script, the person reviewing the script may insert comments about a particular scene or treatment at a point in the document that correlates to the scene or treatment to which the comment pertains. If the user makes a comment about scene 1, that comment is associated with scene 1 so that if another individual revisits the document after the first user inserted the comment that individual can review the first user's comments along with the contents of the document.*

It would appear clear that from at least the above passage that a user's annotations are inserted in and specifically associated with the exact point of insertion.

With respect to appellant's remarks on page 7, it is asserted that, as recited in claims 41 and 42 there is a clear teaching of a single 'master' annotation document. The examiner respectfully disagrees, as this simply is not the case. Aside from the fact that the limitations as claimed in claims 41 and 42 have no bearing or weight on interpretation of claims 1 and 21, these claims merely discuss a querying mechanism for performing save operations on an annotated message. For sake of discussion, even if the insertion of annotations in a document or message were not taught by **SPIELBERG** (which the examiner clearly thinks it is), there is

nothing in claims 41 or 42 that hints at a single file containing original messages, attachments, sound clips, etc.

With respect to appellant's remarks at the top of page 8 alleging that the interpretation of claim 1 is inconsistent with that of the specification, the examiner respectfully disagrees. It has been pointed out in numerous occasions above that not only is the teaching of **SPIELBERG** consistent with appellant's disclosure; in some sections, the teaching is almost verbatim to the language in the claims. Therefore, it is believed that these rejections should stand as presented.

Response to Arguments With Respect to Rejection Under 35 U.S.C. § 103(a)

Claims 19 and 39

Once again, it appears very clear that **SPIELBERG** teaches the insertion of speech annotations or comments. The examiner points to the opening sentence of appellant's remarks directed to claims 19 and 39, in which it is admitted that the system is operable *regardless of when the annotations are inserted*. Worth noting again is a relevant portion of **SPIELBERG** (*see above* Page 2, Paragraph [0019]), which clearly points out that when the document is stored and/or played back, ***the device plays back the document and the comments via the audio output mechanism***. It is very clear that the inserted comments are also stored/played with respect to the location of when annotations [comments] are to be inserted by the user[s].

Further, the examiner fails to see how the obvious feature of saving files (which **SPIELBERG** also implicitly teaches) would in any way render the invention inoperable. Again, it appears the remarks are based around the assumption that one singular 'master' file is being

created in appellant's invention, which it clearly has been pointed out, is not taking place. The claim language in question reads,

> *wherein said step of storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations.*

Based on the above language, it does not appear reasonable for one possessing ordinary skill in the art to make even the broadest assumption that one single 'master' file must be created for successful operation.

Even if it were the case, however, this would still have no effect on the operability of **SPIELBERG** when saving files. Finally, since a merging of files is not even taking place within the disclosure of appellant, it would be unreasonable to enforce said limitations on **SPIELBERG**. Therefore, it is believed that these rejections should stand as presented.

Claims 41 and 42

Remarks concerning claims 41 and 42 were briefly touched on earlier and once again, a single 'master' file being created is the basis behind the remarks and so the above discussion of claims 19 and 39 should suffice to address the majority of appellant's rationale.

Of note, **FULLER** is merely brought in to give a clear disclosure of the ability to overwrite files within a computing environment based on some sort of query, which is well known in the art of computers in general. Therefore, it is believed that these rejections should stand as presented.

Claims 3-4, 6, 11, 20, 23, 24, 26, 31 and 40

Once again, the notion of a single 'master' file is present. In reading the background and summary of **SPIELBERG**, the main motivation for creating the invention was to provide portability to the review of documents. This includes the insertion of annotations in a number of environments (e.g., home office, automobile, cellular telephone, etc.) and available to any number of users. This in of itself could explicitly teach forwarding of said annotated message. The **PIZANO** reference teaches a Unified Messaging system that allows a user to listen to communications (e.g., facsimile, voice mail, e-mail, etc.) and make annotations [comments] regarding the communications. Among other things, **PIZANO** teaches forwarding said original message with attached annotations to the original user (page 4, line 29). Therefore, it is believed that these rejections should stand as presented.

Conclusion

Based on appellant's remarks and on the discussions above, it appears clear that the main point is whether **SPEILBERG** teaches the insertion of annotations into a given original document. Based on at least what has been presented above, this is decisively taking place.

Further, it is believed that the 35 U.S.C. § 103 rejections of claims 3-4, 6, 11, 19-20, 23-24, 26, 31 and 39-42 are in compliance with the guidelines set forth in the Graham v. John Deere Co. factual inquiries and further supported by appropriate rationale in view of *KSR*.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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29 July 2009

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